Mailed: September 9, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Zuffa, LLC

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Serial No. 76402817

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Parker H. Bagley of Milbank, Tweed, Hadley & McCloy LLP for Zuffa, LLC.

Debra Lee, Trademark Examining Attorney, Law Office 116 (Meryl Hershkowitz, Managing Attorney).[1]

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Before Hairston, Chapman and Drost, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Zuffa, LLC (a Nevada limited liability company) filed on May 21, 2002, an application to register on the Principal Register the mark shown below

[1] The application was assigned to this Examining Attorney at the time the Examining Attorney's brief was due.

for goods and services in International Classes 9, 28 and 41. Applicant deleted its Class 9 goods through an amendment filed January 12, 2004. The Class 28 goods were divided out pursuant to applicant's Request to Divide filed December 14, 2004, resulting in related application Serial No. 76977324. Thus, the application before us currently involves only the services in International Class 41 identified as follows:

> "entertainment, namely live stage shows and performances featuring mixed martial arts; educational services, namely, providing information on the subject of sports and entertainment; providing a website on global computer networks featuring information on the subject of sports and entertainment; production of entertainment shows and interactive entertainment programs for distribution via television, cable, satellite, audio and video media cartridges, laser discs, computer discs and electronic means; production and distribution of entertainment shows and news programs via global communication networks."

The application is based on applicant's claimed date of first use and first use in commerce of May 2001 for the services in International Class 41.

Applicant claims ownership of Registration No. 2170463 issued on the Principal Register on June 30, 1998 (Section 8 affidavit accepted, Section 15 affidavit acknowledged) for the mark shown below

for “prerecorded video optical disks featuring sports and entertainment events; prerecorded audio and videotapes featuring sports and entertainment events” in International Class 9; and Registration No. 2576367 issued on the Principal Register on June 4, 2002 for the mark THE ULTIMATE FIGHTING CHAMPIONSHIP for a variety of goods in International Classes 9, 16, 18 and 25.

Registration has been finally refused under Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), on the basis of applicant’s failure to comply with a requirement to disclaim the phrase “ULTIMATE FIGHTING CHAMPIONSHIP.” Such phrase, according to the Examining Attorney, is generic of applicant’s services within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), and therefore must be disclaimed; and even if the phrase is not generic, applicant’s claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), is not sufficient in view of the nature of the proposed mark.

Applicant appealed to the Board. Both applicant and the Examining Attorney have filed briefs. Applicant did not request an oral hearing.

The Examining Attorney contends that the phrase ULTIMATE FIGHTING CHAMPIONSHIP in the mark is generic for applicant's identified services of "entertainment, namely, live stage shows and performances featuring mixed martial arts,"[2] and the phrase is thus incapable of functioning as a mark, it cannot acquire distinctiveness and it must be disclaimed; that the two classes or genus of the services herein are: (i) "championship" defined in MSN Encarta Dictionary as "1. contest to decide a champion: a contest, competition, or tournament that is held to decide who will be the overall winner"; and (ii) "ultimate fighting" is the "name of a type of fight involving a variety of martial arts techniques" (brief, p. 5); that the relevant public understands these terms as referring to these genus of services; that there is substantial evidence of record showing "common usage of the term, 'ultimate fighting,' as a generic term" (brief, p. 11); that applicant may have coined the phrase but it has "come to be regarded by the

[2] Both the Examining Attorney and applicant focused on this single item in applicant's identification of services, and the Board will do likewise.

purchasing public as nothing more than a descriptive designation" (brief, p. 12); that there is nothing incongruous or unique about this phrase; and that even if the phrase is held not to be generic, the words "fighting" and "championship" are generic for fighting competitions,[3] making the phrase ULTIMATE FIGHTING CHAMPIONSHIP highly descriptive, and increasing applicant's burden of proof to establish acquired distinctiveness, which applicant has not met.

The Examining Attorney submitted (i) printouts of several excerpted stories retrieved from the Nexis database, and (ii) printouts of pages from a few third-party websites, all to show that "ULTIMATE FIGHTING CHAMPIONSHIP" is generic for a type of mixed martial arts competition. Examples of the excerpted stories retrieved from the Nexis database are set forth below:

> Headline: Attorney General Won't Talk About Overnight Stays in A.C.
> …Invoices, instead, show the state paid for Harvey to stay overnight in

[3] The Examining Attorney requested in her brief (footnote 5) that the Board take judicial notice of definitions of "fighting" and "championship" from "Dictionary.com." The request is granted to the extent that we take judicial notice of the references therein to The American Heritage Dictionary (Fourth Edition 2000) definitions of (i) "fighting" as "v. …2a. Sports. To box or wrestle against in a ring. … 3a. A physical conflict between two or more individuals. 3b. Sports. A boxing or wrestling match…"; and (ii) "championship" as "3. A competition or series of competitions held to determine a winner." See In re Total Quality Group Inc., 51 USPQ2d 1474, 1476 (TTAB 1999).

Atlantic City on February 28, 2002, when an ultimate fighting championship was held in Atlantic City , and on …. "Asbury Park Press," November 9, 2003; Headline: Kickboxing's 'Wrath' Unleashed
…Eric Bentz, a black belt instructor at Apollo's Karate, will make his pro debut under ultimate fighting rules against Daryan Wilkerson of Houston. … "Tulsa World (Oklahoma)," September 12, 2003;

Headline: Fighter's Style Paying Off…
… "I really enjoyed wrestling, but I never thought it would lead me anywhere," Lytle said. Apparently his friends thought differently. About five years ago, they persuaded him to participate in an ultimate fighting championship. Strapped for cash, Lytle was lured to he no-holds-barred tournament by potential prize money. … "The Indianapolis Star," August 1, 2003; and

Headline: Sporting Blood
…funding for the regulation of mixed martial arts in California has stalled twice due to budget constraints, said Rob Lynch, executive officer of the California State Athletic Commission. Lynch said that while the commission is concerned about choke holds, ultimate fighting may be less dangerous than boxing, in which competitors absorb more blows to the head. Two boxers have been killed in California since 1983.
No one has been killed in the UFC, and while beatings are often vicious and bloody, the most serious injuries are usually the same sort of ligament tears seen … "The San Francisco Chronicle," July 19, 2002.

Applicant argues that the phrase ULTIMATE FIGHTING CHAMPIONSHIP is not generic for applicant's identified entertainment services of live stage shows and performances; that the Examining Attorney has established neither that ULTIMATE FIGHTING CHAMPIONSHIP names the genus or class of services at issue here nor that the relevant public understands the term to refer to that class of services; that the commonly used names for applicant's services include "mixed martial arts fighting," "no holds barred fighting" and "extreme fighting" but that ULTIMATE FIGHTING CHAMPIONSHIP identifies applicant and its goods and services; that the evidence of record does not meet the Examining Attorney's burden necessary to establish genericness, particularly as the Examining Attorney's Nexis and Internet evidence shows "third[-]party uses of applicant's mark" (brief p. 9), with many of the articles referring to applicant or to applicant's fighters; that some misuses by media writers are sporadic and do not destroy applicant's use of the phrase as a mark recognized by the public; that doubt on the issue of genericness is resolved in favor of applicant; and that applicant has established acquired distinctiveness in the phrase ULTIMATE FIGHTING CHAMPIONSHIP.

The test for determining whether a designation is generic, as used in connection with the services in an application, turns upon how the term or phrase is perceived by the relevant public. See Loglan Institute Inc. v. Logical Language Group, Inc., 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992). Determining whether an alleged mark is generic involves a two-step analysis: (1) what is the genus of the goods or services in question? and (2) is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services? See In re The American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); and H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). As noted earlier, "the correct legal test for genericness, as set forth in *Marvin Ginn*, supra, requires evidence of 'the genus of goods or services at issue' and the understanding by the general public that the mark refers primarily to 'that genus of goods or services.'" American Fertility Society, supra.

The Examining Attorney bears the burden of proving that the proposed phrase is generic, and genericness must be demonstrated through "clear evidence." See In re Merrill Lynch, Pierce, Fenner, & Smith, Inc., 828 F.2d

1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987); and In re Analog Devices Inc., 6 USPQ2d 1808 (TTAB 1988), aff'd, unpubl'd, but appearing at 10 USPQ2d 1879 (Fed. Cir. 1989). The evidence of the relevant public's perception of a term or phrase may be acquired from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications. See Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and In re Leatherman Tool Group, Inc., 32 USPQ2d 1443 (TTAB 1994), citing In re Northland Aluminum Products, Inc., 777 F.2d 1566, 227 USPQ 961 (Fed. Cir. 1985).

In this case, the Examining Attorney has submitted some evidence of generic use of the words "ultimate fighting" to refer to a sporting competition. However, the record shows that the majority of the examples are direct or indirect (that is, events or personalities associated with applicant's services) references to applicant. There are relatively few references that simply show generic use of the phrase to refer to sporting events. Applicant contends that these are simply sporadic misuses of applicant's ULTIMATE FIGHTING CHAMPIONSHIP by the media, and that applicant cannot realistically take action against all journalists and their uses/misuses of a phrase identifying applicant.

In addition, applicant submitted ten (of thirty-nine) full-text stories retrieved from the Nexis database from the time period January 1, 1984 to January 1, 1994, all of which use "Ultimate Fighting Championship" in initial capital letters, and all refer to applicant and its mixed martial arts contests offered under the mark ULTIMATE FIGHTING CHAMPIONSHIP.

As explained previously, our primary reviewing Court, the Court of Appeals for the Federal Circuit, has held that the burden of establishing genericness of a term or a whole phrase rests with the Office and that the showing must be based on clear evidence. See In re Merrill Lynch, supra, 4 USPQ2d at 1143; and In re The American Fertility Society, supra, 51 USPQ2d at 1835. Because the record before us shows varied uses of the phrase "ULTIMATE FIGHTING CHAMPIONSHIP," we find that there is insufficient clear evidence that the phrase ULTIMATE FIGHTING CHAMPIONSHIP is the generic or common descriptive term for the live stage shows and performances featuring mixed martial arts to which applicant first applied the phrase.

With regard to the second prong of the genericness test, the evidence of record as to how the relevant

purchasers[4] would perceive this phrase in relation to applicant's identified services involving live shows and performances is mixed. There is significant evidence of ULTIMATE FIGHTING CHAMPIONSHIP clearly referring to applicant and its entertainment services offered under the mark UFC ULTIMATE FIGHTING CHAMPIONSHIP and design. Moreover, none of the evidence submitted by the Examining Attorney predates applicant's first use in May 2001. Thus, the Examining Attorney has not established that the relevant purchasing public would perceive the phrase ULTIMATE FIGHTING CHAMPIONSHIP as the name of the genus of the entertainment services namely, live shows and performances.

We find that the Examining Attorney has not established a prima facie showing that the phrase ULTIMATE FIGHTING CHAMPIONSHIP is generic for applicant's identified entertainment in the form of live shows and performances services featuring mixed martial arts.

There is sufficient evidence regarding use of the phrase "ULTIMATE FIGHTING CHAMPIONSHIP" in connection with sporting events and competitions to establish that the

[4] The Board finds that the relevant purchasers are fans who either attend or purchase pay-per-view for the live stage shows and performances of this mixed martial arts medium.

phrase is merely descriptive thereof. See In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Thus, we will now determine whether applicant has submitted sufficient evidence of acquired distinctiveness under Section 2(f) to overcome the mere descriptiveness of the phrase.

Applicant has the burden of establishing that its mark has become distinctive. See Yamaha International Corp. v. Hoshino Gakki Co. Ltd., 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). The question of acquired distinctiveness is one of fact which must be determined on the evidence of record. As the Board stated in the case of Hunter Publishing Co. v. Caulfield Publishing Ltd., 1 USPQ2d 1996, 1999 (TTAB 1986):

> [e]valuation of the evidence requires a subjective judgment as to its sufficiency based on the nature of the mark and the conditions surrounding its use.

There is no specific rule as to the exact amount or type of evidence necessary at a minimum to prove acquired distinctiveness, but generally, the more descriptive the term, the greater the evidentiary burden to establish acquired distinctiveness. See In re Bongrain International (American) Corp., 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); and Yamaha International Corp. v. Hoshino Gakki Co.

Ltd., supra 6 USPQ2d at 1008. See also, 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§11:17 and 15:66 and 15:70 (4th ed. 2005).

Having carefully reviewed the evidence of record, we find that applicant's evidence of acquired distinctiveness is sufficient to establish a prima facie showing thereof.[5] Applicant has submitted a claim of ownership of two registrations; 31 declarations by various people in the mixed martial arts field; printouts of applicant's website pages showing the list of applicant's fighters; a photocopy of the State of Nevada statute defining "mixed martial arts" (not using the words "ultimate fighting"); and evidence of applicant's policing of that portion of its mark comprising ULTIMATE FIGHTING CHAMPIONSHIP, including photocopies of (i) a court decision and (ii) a settlement agreement whereby applicant stopped two different entities from using the mark.

Specifically, the record shows that applicant has used the applied-for mark (including the words ULTIMATE FIGHTING CHAMPIONSHIP) for applicant's entertainment services since May 2001. Applicant claims ownership of two Principal

[5] In this case, the Examining Attorney contends that the phrase is highly descriptive thereby carrying a high threshold of proof from applicant. Even assuming that the phrase is highly descriptive of the identified services, we find that applicant's evidence of acquired distinctiveness is sufficient.

Register registrations -- Registration No. 2170463 for the mark THE ULTIMATE FIGHTING CHAMPIONSHIP and design for "prerecorded video optical disks featuring sports and entertainment events; prerecorded audio and videotapes featuring sports and entertainment events" in International Class 9; and Registration No. 2576367 for the mark THE ULTIMATE FIGHTING CHAMPIONSHIP for a variety of goods in International Class 9 (e.g., "eyeglasses," "binoculars," "prerecorded audio tapes featuring sports and entertainment events"); Class 16 (e.g., "note paper dispensers," "pens," "pencils," "maps," "general feature and sports, fitness and entertainment magazines"); Class 18 (e.g., "knapsacks," "handbags," "walking sticks," "duffel bags"); and Class 25 (e.g., "belts," "socks," "playsuits," "ear muffs," "parkas," "team uniform reproductions"). Neither of applicant's two claimed registrations includes a disclaimer or a claim of acquired distinctiveness.

We agree with the Examining Attorney that applicant's claim of ownership of these two registrations is not sufficient by itself to establish a prima facie claim of acquired distinctiveness. See TMEP §1212.04 (4th ed. rev. 2005). The mark in the claimed registration with a design feature (No. 2170463) is not the "legal equivalent" of the mark now presented for registration. However, the mark in

Registration No. 2576367, THE ULTIMATE FIGHTING CHAMPIONSHIP, is virtually identical to the portion of the applied-for mark, which the Examining Attorney has rejected. An applicant can rely "to some degree" on the distinctiveness which its mark has achieved for the registered goods to help demonstrate that the mark has become distinctive of related goods or services. Bausch & Lomb Inc. v. Leupold & Stevens Inc., 6 USPQ2d 1475, 1477 (TTAB 1988). See also, In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807, 1813 (Fed. Cir. 2001). Applicant now seeks to register the words ULTIMATE FIGHTING CHAMPIONSHIP (as part of a composite mark with letter and design features) for entertainment services of live shows and performances, and the types of goods included in its claimed registrations are arguably collateral or merchandising type goods which would be sold in conjunction with the live shows. See Turner Entertainment Co. v. Nelson, 38 USPQ2d 1942, 1945-1946 (TTAB 1996). However, as stated in Bausch & Lomb, supra, 6 USPQ2d at 1477": "applicant must nevertheless present some direct evidence showing that its [mark] has become distinctive vis-a-vis [the current goods/services]."

Importantly, applicant has submitted 31 declarations of various people in the mixed martial arts field including

Dr. Tony Alamo, Vice-chairman of the Nevada State Athletic Commission; Keith Kizer, Chief Deputy Attorney General, Gaming Division for the state of Nevada, and chief legal counsel for the Commission; Marcos Rosale Jr., a judge for the Nevada State Athletic Commission; A. L. Embanato, Jr., Vice-chairman of the Louisiana State Boxing & Wrestling Commission; managers and trainers of mixed martial arts fighters -- Peter Welch, boxer/trainer, and Donald House, trainer; owners of competing mixed martial arts events -- Reed Harris, VP World Extreme Cagefighting, and Dan Lambert, president Absolute Fighting Championship; and members of the media -- Ryan Bennett, NBC sports anchor, and Loretta Hart, journalist. In each of the 31 declarations, the declarant avers that within the industry ULTIMATE FIGHTING and ULTIMATE FIGHTING CHAMPIONSHIP are each trademarks owned by applicant; that the marks are used to identify the specific mixed martial arts competitions promoted by applicant; and that due to applicant’s long and extensive use of those trademarks, those in the industry as well as the fans of mixed martial arts associate the marks exclusively with applicant.

These declarations are significant direct evidence of purchaser and user recognition of the phrase ULTIMATE

FIGHTING CHAMPIONSHIP as identifying applicant's involved identified entertainment services.

We find that applicant's cumulative evidence is sufficient to establish acquired distinctiveness in ULTIMATE FIGHTING CHAMPIONSHIP as a portion of the applied-for mark for the identified services. See In re Mine Safety Appliances Company, 66 USPQ2d 1694 (TTAB 2002).

Decision: The requirement for a disclaimer of the phrase "ULTIMATE FIGHTING CHAMPIONSHIP" as generic is reversed; and the refusal to register the mark under Section 2(f) of the Trademark Act is reversed. Accordingly, the application will proceed to publication with a notation of applicant's claim of acquired distinctiveness under Section 2(f).